Remarks:

Reconsideration of the application is requested.

Claims 1-12 are now in the application. Claims 1, 4-5, 8, and 11-12 have been amended.

In item 1 on page 2 of the above-identified Office action, the proposed drawing corrections have been disapproved. The Examiner stated that the proposed drawing correction appear to contain inconsistencies both within the drawing itself and between the drawing and specification. The Examiner stated that "numeral 12 appears to depict two different features while there appears no numeral 15 in the specification." The Examiner's comments have been noted and the appropriate corrections have been made to Fig. 4 of the drawings.

In item 2 on page 2 of the Office action, the drawings have been objected to for not showing certain features under 37 CFR 1.83(a). More specifically, the Examiner has stated that the following recited features:

> "outer peripheral border region … in a latched state";
>
> "free gap … being open toward said border region, bounded inwardly by said inner contour and by said expansible

shaped element and having a shape corresponding substantially to said shaped element"; and

"latching devices are integrally formed on an outer border of one of said half-shells";

must be shown. The feature "outer peripheral border region … in a latched state" has been cancelled from claim 1 (This will be discussed in great detail in the remarks concerning the rejections in items 4 and 6 of the Office action). The feature "free gap … being open toward said border region, bounded inwardly by said inner contour and by said expansible shaped element and having a shape corresponding substantially to said shaped element" has been extensively re-written. Furthermore, the specification (page 9 ,line 24) has been amended by inserting reference numeral 15 after the word "gap".

In item 4 on page 3 of the Office action, claims 1-10 have been rejected as being indefinite under 35 U.S.C. § 112, first paragraph.

More specifically, the Examiner has stated that the following recited features: "outer peripheral border region … in a latched state", "free gap … being open toward said border region, bounded inwardly by said inner contour and by said

expansible shaped element and having a shape corresponding substantially to said shaped element", and "latching devices … integrally formed on an outer border of one of said half-shells" are not (sufficiently) described in the specification.

In item 6 on pages 3-4 of the Office action, claims 1-10 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

More specifically, the Examiner has stated that in regard to claim 1 it is not clear what is defined by the term "outer peripheral border region … in a latched state" and "free gap … being open toward said border region, bounded inwardly by said inner contour and by said expansible shaped element and having a shape corresponding substantially to said shaped element". The Examiner's comments, together with the Examiner's comments in item 4, have been noted and claim 1 was re-written in order to more clearly state the invention and to overcome the numerous § 112 rejections. In particular, the phrase "said half-shells forming an outer peripheral border region therebetween in said latched state" has been deleted since it is not essential for the statutory mandate of *particularly pointing out and distinctly claiming*.

In regard to claim 5, the Examiner stated that "said latching devices" lacks an antecedent basis within the claims. Appropriate correction has been made to claim 5.

In regard to claim 8, the Examiner has stated that it is not clear as to how latching devices are disposed upon an "outer border of one of said half-shells". The appropriate corrections have been made to claim 8.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, Counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for the purpose of satisfying the requirements of 35 U.S.C. § 112. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

In item 7 on pages 4-5 of the Office action, claims 1 and 9-12 have been rejected as being anticipated by *Miura et al.* (US 4,369,608) under 35 U.S.C. § 102.

In item 9 on page 5 of the Office action, claims 1-9, 11, and 12 have been rejected as being anticipated by *Hull et al.* (US 5,419,606) under 35 U.S.C. § 102.

In item 10 on page 5 of the Office action, claims 1-9, 11, and 12 have been rejected as being anticipated by *Berdan et al.* (US 5,353,571) under 35 U.S.C. § 103.

The rejections have been noted and claims 1 and 11 have been amended to recite a heat-expansible element, in an effort to even more clearly define the invention of the instant application. Support for the changes is found on page 2, lines 2-4, of the specification.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 as amended (similarly claim 11) calls for, inter alia:

> a ***heat-expansible*** element constructed as a contoured ring-like plate;
>
> a retaining device to be positioned in a cross-sectional region of a cavity, said retaining device having two separately produced half-shells being latched to one another at a distance from one another using a latching

device, said heat-expansible element being retained between said half-shells;

one of said half-shells having an inner contour;

said half-shells defining a free gap therebetween, said free gap being bounded inwardly by said inner contour and said heat-expansible element; and

said heat-expansible element having a shape corresponding substantially to said free gap.

Miura et al. disclose a ***hardened*** thermosetting material bounded to an outer panel, and therefore, does not disclose a heat-expansible element as recited in claim 1. Also *Miura et al.* do not disclose a free gap between the half-shells where the expansible element has a shape corresponding substantially to the free gap.

Regarding *Hull et al.* the Examiner stated on page 5 of the Office action that Fig. 2 of *Hull et al.* shows "an expansible shaped element". However, the element is already hardened or already has its final shape. Hence *Hull et al.* does not disclose a heat-expansible element as recited in claim 1. Also *Hull et al.* do not disclose a heat-expansible element having a shape corresponding substantially to a free gap between the half-shells, as recited in claim 1.

Regarding *Berdan et al.* the Examiner stated on page 5 of the Office action that in *Berdan et al.* the device with the reference numeral 110 is "an expansible element". However, the device in *Berdan et al.* with the reference numeral 110 is a mere resilient spacer and, therefore, is not a heat-expansible element as recited in claim 1. In particular, *Berdan et al. do not* show a heat-expansible element being expansible under the influence of heat and whose shape corresponding substantially to a free gap between the half-shells.

Clearly, neither *Miura et al.*, *Hull et al.*, nor *Berdan et al.* show the features recited in claims 1 and 11 of the instant application. Therefore, the invention as recited in claims 1 and 11 of the instant application is believed not to be anticipated by the references.

One underlying inventive concept of the invention of the instant application is to use a retaining device containing heat-expansible material. The heat-expansible material, as stated on page 4, lines 12-20, of the instant application, "is only provided wherever it is actually required for sealing purposes and, with a predetermined flow direction, can also expand without obstruction in the direction of the hollow-body wall which is to be sealed, while the material flow to the

center of the half-shell is bounded by the inner contour provided on one half-shell." The advantages of the recited retaining device are disclosed on page 4, lines 1-10, of the instant application. The references neither disclose or suggest such a retaining device using a heat-expansible element. Therefore, the invention as recited in claims 1 and 11 of the instant application is believed also not to be obvious over *Miura et al.*, *Hull et al.*, or *Berdan et al.*.

It is accordingly believed to be clear that neither *Miura et al.*, *Hull et al.*, nor *Berdan et al.* show the features of claims 1 and 11. Claims 1 and 11 are, therefore, believed to be patentable over the art and since claims 2-9 are ultimately dependent on claim 1 and claim 12 is dependent on claim 11, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-12 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, the Examiner is respectfully requested to telephone counsel so that, if possible, patentable language can be worked out. In the alternative, the entry of the amendment is requested as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

Please charge any fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

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REG. NO. 37,006

For Applicant

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Version with markings to show changes made:

Page 9, line 18, through page 10, line 3,--
In an automated process, the three plates, namely the two half-shells 1, 9 and the shaped element 8, are laid one upon the other, latched to one another and, in this form, are positioned in the relevant cavity. During subsequent heating, the expansible shaped element 8, which fills merely a border region between the two half-shells 1, 9, expands in a predetermined direction, namely in an open gap 15 between the two half-shells, in the direction of the adjacent inner wall 12. Expansion in the inward direction is prevented by the integrally formed inner contour 2 and expansion in the transverse direction is prevented by virtue of the fact that material is not provided there. --

Claim 1 (twice amended). A configuration for separating cavities for sealing or sound-proofing, comprising:

[an expansible] a heat-expansible [shaped] element constructed as a contoured ring-like plate; [and]

a retaining device to be positioned in a cross-sectional region of a cavity, said retaining device having two separately produced half-shells [to be] being latched to one

another at a distance from one another using a latching device, said [expansible shaped] heat-expansible element being retained between said half-shells;

one of said half-shells having an inner contour;

[said half-shells forming an outer peripheral border region therebetween in said latched state; and]

said half-shells defining a free gap therebetween [being open toward said border region], said free gap being bounded inwardly by said inner contour and said heat-expansible element; and [by]

said [expansible shaped] heat-expansible element [and] having a shape corresponding substantially to said [shaped element] free gap.

Claim 4 (twice amended). The configuration according to claim 1, wherein said [shaped] heat-expansible element has material-free spaces in the area next to said latching device.

Claim 5 (twice amended). The configuration according to claim 1, wherein said two half-shells are first and second half-shells, said first half-shell has said inner contour, said second half-shell has a region corresponding to said inner contour, and said latching [devices are] device is disposed

within said inner contour and said region of said second half-shell.

Claim 8 (twice amended). The configuration according to claim 1, wherein said latching device is integrally formed on [a border] an inner surface of one of said half-shells [for connection to an inner wall of a cavity to be separated off].

Claim 11 (amended). A configuration for separating cavities for sealing or sound-proofing, comprising:

[an expansible] a heat-expansible element; and

a retaining device to be positioned in a cross-sectional region of a cavity, said retaining device having two half-shells [to be] being fixated to one another [such as to have] with a free gap between said two half-shells, [said two half-shells having a shape corresponding substantially to said expansible element,] and said heat-expansible element being retained between said two half-shells.

Claim 12 (amended). The configuration according to claim 1, wherein one of said two half-shells has an inner contour enclosing said [expansible] heat-expansible element.--